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HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER WILLIAMS, JAMILA O	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/521,192

Applicant(s)

STAUB ET AL.

Examiner

Jamila Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1-13-05, 5-13-05
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one window opening recited in claim 5 and the position markings and/or numbers recited in claim 9 and the base film having security features, as recited in claim 15 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 9, it is unclear what is encompassed by the phrase "(barcodes)". It is not clear how the inclusion of this recitation (and the associated parenthesis) further limit the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6-9,16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,808,792 to Weber in view of WO 93/12940 to Vermeulen et al (hereinafter Vegmeulen).

Weber discloses an individualized security document (passport, substate 8 and column 1 lines 31-33 and column 2 lines 20-21 discloses the substate being a passport) having a transfer film (figure 2) which is provided with security elements and which has a base film (3) and a decorative layer arrangement (12,19) having the security elements (36), the decorative layer arrangement having an adhesive 15 on the side remote from the base film. Weber also discloses in column 7 lines 39-44 that the transfer film element (17) be of a size that is the same as the size of the substrate (page of the passport).

Weber does not however disclose the security document (passport) having a number of pages joined together by means of a fixing or adhesive.

Vegmeulen teaches having a security document (passport) having a number of pages joined by a fixing (stitching, page 2 last paragraph of Vegmeulen).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the pages and binding or fixing of Vegmeulen with the passport of Weber for the purpose of securing various amounts of information together in the passport.

In the event that it is later deemed that Weber modified by Vegmeulen does not provide for the transfer film being incorporated into the document by means of the fixing, the examiner provides the following rejection.

It is well known in the binding art to fix or bind sheets together for the purpose of forming a complete assembly and prevent sheets from being lost or misplaced. In light of these teachings and the fact that Vegmeulen teaches having sheets attached via a binding, it would have been obvious to one having ordinary skill in the art at the time the invention was made to bind all of the sheets (including the transfer film, which is disclosed as being of equal size to the sheet of the passport and therefore essentially forms a sheet) for the purpose of providing a complete assembly and prevent any sheet from being misplaced. Additionally, applying binding to multiple sheets of a passport is known in the art and one skilled in the art could combine the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable result to one having ordinary skill in the art at the time the invention was made.

Regarding claim 2, Weber modified by Vegmeulen discloses the transfer film provided with security elements is transparent column 3 line 42 of Weber).

Regarding claim 3, Weber modified by Vegmeulen discloses the transfer film comprises paper (column 7 lines 48 and 55 of Weber).

Regarding claim 4, Weber modified by Vegmeulen discloses the decorative layer (7 of Weber) having security elements is temporarily connected by means of a release layer (9 of Weber) to a carrier film (5 of Weber) which is permanently connected to the base film (3 of Weber) by means of permanent adhesive (4 of Weber).

Regarding claim 6, Weber modified by Vegmeulen discloses the decorative layer arrangement is applied in the form of a label to the base film or the carrier film which is permanently connected to the base film (figure 2-3 of Weber).

Regarding claim 7, Weber modified by Vegmeulen discloses the decorative layer arrangement is laminated onto the base film or onto the carrier film which is permanently connected to the base film (figure 2-3 of Weber).

Regarding claim 8, Weber modified by Vegmeulen discloses the decorative layer arrangement is transparent or partially transparent (column 3 line 42 of Weber).

Regarding claim 9, Weber modified by Vegmeulen discloses the base film and/or carrier film provided with position markings (perforations 16 are being considered the position markings).

Regarding claim 16, Weber modified by Vegmeulen discloses the transfer film provided with security elements is of surface dimensions adapted to a page of the security document (column 7 lines 39-44 of Weber).

Regarding claim 17, wherein the transfer film is provided with security elements of surface dimensions adapted to a double page of the security document. It would have been an obvious matter of design choice to size the transfer film as claimed since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber in view of Vegmeulen and further in view of 5,103,583 to VanErmen.

Weber modified by Vegmeulen discloses most elements of the claims but for the base film having a window or opening.

VanErmen teaches having a label system having a base film (backing 12) with a window. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the window of VanErmen with the base film of Weber modified by Vegmeulen for the purpose of viewing indicia or allowing for the addition of indicia on the underlying surface. It is noted that Weber discloses the transfer film as being label-like in its arrangement (column 6 lines 28-31 and column 7 lines 36-44 of Weber), therefore the combination with VanErmen would have been obvious to one having ordinary skill in the art.

Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber in view of Vegmeulen and further in view of 4,533,160 to Malone.

Weber discloses that the transfer film is sized to be the same as the substrate (page of a passport- column 7 lines 39-44, this transfer film therefore essentially forms a sheet) and Vegmeulen teaches having a passport book with multiple sheets and stitching to combine the sheets.

Weber modified by Vegmeulen does not however disclose the base film is provided with a perforation.

Malone discloses a book having layered sheets that are separated via perforations (24). In that the base film is part of the sheet bound in the book as taught by Weber modified by Vegmeulen it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the perforations as taught by Malone with the sheet



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of Weber modified by Vegmeulen for the purpose for allowing for removal from the book.

Regarding claims 11-14, Weber modified by Vegmeulen and Malone discloses perforations in layered sheets. Regarding the specific arrangement of the perforations, in that it is known to have perforations to separate the wanted portions of a sheet (or layers thereof) it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the position of the perforation as a matter of design choice. Additionally, the positioning of the perforation would have been obvious because applying a particular known technique to improve similar devices in the same way is recognized as part of ordinary capabilities of one skilled in the art.

Regarding claim 15, in that the base film of Weber modified by Vegmeulen and Malone comprises paper it is inherently capable of supporting security features. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include security features on the base film as suited for the intended use.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JW 10-17-2007

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